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PATENT TRADEMARK OFFICE

M&F, LLP Ref. No.: 2976-4037

PATENTDocket No.: HUM00-23**IN THE UNITED STATES OF AMERICA PATENT AND TRADEMARK OFFICE**

Applicant(s) : Tim KEITH et al.

Serial or Patent No. : 09/627,465

Group Art Unit : 1646

Filed or Issued : July 28, 2000

Examiner : To Be Assigned

For : **NOVEL HUMAN GENE RELATING TO RESPIRATORY
DISEASE AND OBESITY**Commissioner of Patents
Washington, DC 20231**STATEMENT OF FACTS IN SUPPORT OF FILING ON
BEHALF OF OMITTED INVENTOR WHO REFUSES TO
EXECUTE DECLARATION (37 C.F.R. § 1.47(a))**

I, Leslie Serunian, hereby declare as follows:

1. I am a registered patent agent employed at Morgan & Finnegan, LLP ("Morgan & Finnegan"), 345 Park Avenue, New York, New York 10154-0053. Morgan & Finnegan has been retained by Genome Therapeutics Corporation ("GTC"), 100 Beaver Street, Waltham, Massachusetts 02453-8443 to prosecute and handle all matters relating to the above-referenced patent application in the U.S. Patent and Trademark Office. An Associate Power of Attorney/Change of Correspondence address to Morgan & Finnegan was filed in this application on February 16, 2001. A copy of this paper is attached as Exhibit 1. In my capacity as a registered patent agent, I prepare and prosecute patent applications, and prepare and file accompanying

documents to complete application filings. At Morgan & Finnegan, I am responsible for the handling and prosecution of the subject patent application.

2. I am making this declaration on behalf of GTC, 100 Beaver Street, Waltham, Massachusetts 02453-8443, at which the invention of the above-referenced patent application was made and to whom the above-identified patent application is to be assigned, as to the exact facts which are relied upon to establish the diligent effort made to secure the execution of the declaration and an assignment by the non-signing joint inventor, Sunil Pandit, who refuses to execute the same in the above-identified patent application. The filing of an executed declaration in the subject application is in response to a Notice to File Missing Parts (Filing Date Granted) mailed from the United States Patent and Trademark Office ("USPTO") on October 5, 2000.

3. I have first-hand knowledge of the facts stated herein.

DETAILS OF OMITTED INVENTOR WHO HAS REFUSED TO SIGN APPLICATION PAPERS

4. The inventors of above-identified patent application are Tim KEITH, Randall LITTLE, Paul VAN EERDEWEGH, Josée DUPUIS, Richard DEL MASTRO, Jason SIMON, Kristina ALLEN and Sunil PANDIT. The application was filed on July 28, 2000, without a declaration or an assignment, and with first inventor Tim Keith named on the Application Transmittal document, a copy of which is attached as Exhibit 2.

5. A Notice to File Missing Parts of a Nonprovisional Application -- Filing Date Granted -- was mailed from the U.S. Patent and Trademark Office for this application on

October 5, 2000. To prepare for submitting a declaration executed by all of the joint inventors in response to the Notice to File Missing Parts, I prepared a Combined Declaration and Power of Attorney document ("declaration") and an assignment document for this application, after obtaining the current residence addresses and whereabouts of the named inventors. For those inventors currently employed at GTC, I sent the declaration and assignment papers to GTC to be signed by the named inventors presently at GTC. Two of the inventors, Jason Simon and Sunil Pandit, are no longer employed at GTC. Therefore, I sent the complete patent application, including the specification, claims, drawings and abstract, along with a declaration and assignment to Jason Simon at his current residence address by overnight mail, along with a return self-addressed overnight mail envelope for his use in returning the completed documents to me. Jason Simon returned the executed declaration and assignment to me within five business days following receipt, as requested. I also sent the complete patent application, including the specification, claims, drawings and abstract, along with the declaration and assignment papers, to the current residence address of co-inventor, Sunil Pandit, who is no longer employed at GTC. As detailed hereinbelow, I have made numerous attempts to request that S. Pandit sign the declaration and assignment sent to him and return the completed papers for filing in the subject patent application; however, he remains unresponsive and noncompliant. Joint inventors Tim KEITH, Randall LITTLE, Paul VAN EERDEWEGH, Josée DUPUIS, Richard DEL MASTRO, Jason SIMON and Kristina ALLEN have each executed an assignment of their respective rights to the subject matter of the above-identified patent application to GTC. (A true copy of the assignment filed in this application on March 20, 2001, is attached as Exhibit 3).

6. Inventor Sunil Pandit is a former employee of GTC, who, along with joint inventors T. Keith, R. Little, P. Van Eerdewegh, J. Dupuis, R. Del Mastro, J. Simon and K. Allen, invented the subject matter of the above-identified patent application during the course of their employment at GTC. These same individuals are named co-inventors on related patent application filings, namely, U.S. Serial No. 09/548,588, filed April 13, 2000; U.S. Serial No. 09/548,797, filed April 13, 2000; U.S. Serial No. 09/548,954, filed April 13, 2000 and U.S. Serial No. 09/627,937, filed July 28, 2000, the prosecution of which I am also overseeing at Morgan & Finnegan. A Statement of Facts accompanying a Petition under 37 C.F.R. §1.47(a) in response to a Notice to File Missing Parts, has been submitted in each of the aforementioned applications because Sunil Pandit has refused to sign the declaration and assignment documents sent to him for execution in each of the related patent application filings.

7. Pursuant to 35 U.S.C. § 116 and 37 C.F.R. § 1.47(a) in the instant application, inventors T. Keith, R. Little, P. Van Eerdewegh, J. Dupuis, R. Del Mastro, J. Simon and K. Allen have executed the enclosed declaration on behalf of themselves and on behalf of non-signing joint inventor S. Pandit, who does not respond to or personally acknowledge my repeated attempts to contact him and to request that he sign the declaration and assignment documents sent to him. As is set forth below, Morgan & Finnegan, on behalf of GTC, has acted diligently and in good faith in making a *bona fide* attempt to request that inventor S. Pandit execute the declaration and assignment for the subject patent application and to obtain inventor S. Pandit's execution of the application papers for this patent application.

8. On February 14, 2001, I personally sent a transmittal letter and copies of the

complete patent application papers (including the specification, claims, drawings and abstract), together with a declaration of patent application to S. Pandit, at the following address: 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 by overnight mail. A copy of the first page of the letter containing the tracking number of the overnight mail certificate is attached as Exhibit 4. In the transmittal letter accompanying the enclosed documents, I requested that S. Pandit read the application prior to signing and dating the declaration for patent application. Also included with the transmittal letter was a return overnight mail envelope self-addressed to Morgan & Finnegan. I explained in the letter that the self-addressed mailer was for S. Pandit's use in returning the signed declaration to me at Morgan & Finnegan. In addition, I requested that the signed and dated declaration be returned to me at Morgan & Finnegan in five (5) business days after he had received it. (A true copy of the complete letter that accompanied the application and related papers, and the declaration, is attached as Exhibit 5). On February 15, 2001, I used the overnight mail tracking number to confirm that the application and declaration package had been delivered to S. Pandit's Gaithersburg, MD address. A copy of the tracking information indicating that the overnight package had been delivered is attached as Exhibit 6.

9. On February 26, 2001, I personally sent another letter to S. Pandit, which accompanied an assignment document for his completion. The letter and assignment were sent to Sunil Pandit's current known address at 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 by overnight mail. A copy of the first page of the letter containing the tracking number of the overnight mail certificate is attached as Exhibit 7. In the transmittal letter accompanying the enclosed assignment document, I requested that S. Pandit sign and date the assignment. I also

requested that his signature be notarized, but I informed him that notarization was not required. Also included with the transmittal letter was a return overnight mail envelope self-addressed to Morgan & Finnegan. A copy of the self-addressed, return overnight mailing label is attached as Exhibit 8. I explained in the February 26, 2001 letter that the self-addressed mailer was for S. Pandit's use in returning the completed assignment to me. In addition, I requested that the signed and dated assignment be returned to me at Morgan & Finnegan in five (5) business days after he had received it. (A true copy of the complete letter that accompanied the assignment document is attached hereto as Exhibit 9). On February 27, 2001, I used the overnight mail tracking number to confirm that the assignment package had been delivered to S. Pandit's Gaithersburg, MD address. A copy of the tracking information indicating that the overnight package had been delivered is attached as Exhibit 10.

10. On February 15, 2001, the day after I had overnight mailed the complete application and the declaration to S. Pandit, and had tracked the delivery of the package (See, ¶8 supra), I personally telephoned S. Pandit at his residence address in the evening after business hours to inform him that I had sent the complete application, and the declaration by overnight mail, and to confirm that S. Pandit would read the application and sign the declaration as indicated upon receipt. However, I was connected only to his telephone answering machine on which I left a message, identifying myself, explaining the purpose of the telephone call, and requesting that he call me to confirm that he had received my letter, the complete application and the declaration.

10a. At two different times after normal business hours on February 16, 2001, I telephoned S. Pandit at his residence address and again was connected only to his telephone

answering machine.

10b. On February 19, 2001, I again telephoned S. Pandit at his home telephone number during the day. S. Pandit's wife answered the telephone and told me that S. Pandit was not at home, but that he would be at home later and that I should call back between the hours of 7:30 PM and 9:30 PM that night. Thereafter, I placed three telephone calls to S. Pandit between the appointed hours of 7:30 PM and 9:30 PM on February 19, 2001, the last call being at about 9:30 PM. No one personally answered any of my calls; however, the answering machine connected and a message thereon requested that the caller leave a message, which I did.

10c. On the evening of February 20, 2001, I again called S. Pandit at his home telephone number. I again reached only the answering machine and I left another detailed message explaining that I had called and requesting that S. Pandit return my call to confirm that he would or would not sign the declaration for application.

10d. On February 27, 2001, I telephoned S. Pandit at his home at two separate times -- at 8:40 PM and at 9:55 PM -- to confirm that he had received the assignment document sent to him on February 26, 2001, as well as the previously-sent documents, and to determine if he would sign the declaration and assignment documents as I had requested. Both of my calls were not answered, although I was connected to the answering machine. At the time of the second call, I left a detailed message for S. Pandit to kindly call me collect at my office telephone number to discuss the papers that had been sent to him.

10e. On March 2, 2001, I telephoned S. Pandit at his home telephone number in the

evening after normal business hours. No one answered the telephone. I again left a message on the answering machine in which I requested that he call me, collect, if necessary, so that I might speak to him directly regarding the application, declaration and assignment documents.

11. In spite of numerous attempts to speak directly to S. Pandit, he did not personally answer his telephone at any time. Also, despite my repeated messages and requests asking that he call me, and/or kindly answer his telephone, I have received no return telephone calls from Sunil Pandit. I have I received no form of communication from him. In addition, to date, S. Pandit has not returned either an executed declaration or an executed assignment document as requested.

12. On March 7, 2001, I sent S. Pandit a letter by certified mail which confirmed that he intends not to sign the declaration and assignment documents that have been sent to him for the above-identified patent application. (Exhibit 11). No response to this letter has been received from S. Pandit.

13. On March 16, 2001, the Federal Express Mail Office in Rockville, MD telephoned the mailroom at Morgan & Finnegan and reported that the apartment rental office of S. Pandit's 353 W Side Drive, Gaithersburg, MD address had returned the Federal Express package that had been delivered there on February 27, 2001. I immediately telephoned the Federal Express office and was told by a representative that Federal Express had tried, on three separate occasions, to deliver the overnight package directly to S. Pandit's apartment (Apt. No. 202) on February 27, 2001, but that no one had answered the door. On that same day, the package for S. Pandit was left with and signed for by an individual in the apartment rental office in the building at 353 W Side Drive, Gaithersburg, MD. Thereafter, on March 16, 2001, an individual in the rental office at 353 W Side Drive,

Gaithersburg, MD telephoned the Federal Express office and told the Federal Express representative that S. Pandit had moved. After learning of the above account, I instructed Federal Express to return the undelivered package to me at Morgan & Finnegan.

14. Upon hearing from the Federal Express representative that S. Pandit had allegedly moved from the 353 W Side Drive, Gaithersburg, MD address, I telephoned S. Pandit at his current telephone number at about 4:15 PM on March 16, 2001. I spoke with his wife who answered the telephone. Mrs. Pandit informed me that she and Sunil Pandit indeed still lived at the same address, i.e., 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878, and that they had not moved. Mrs. Pandit did not answer any of my questions concerning the packages and documents that I had sent to her husband, and claimed to have no knowledge of the reason that her husband refused to speak with me.

15. As set forth in ¶6 hereinabove, S. Pandit has also refused to sign the declaration and assignment documents for related patent applications on which he is a named co-inventor and which were previously sent to him. The actions of Sunil Pandit, as recounted herein, evidence his unwillingness to cooperate in the filing of a complete patent application. In view of S. Pandit's continued refusal to respond to my telephone calls and messages, his refusal to personally acknowledge receipt of the documents sent to him, and his refusal to execute and return the completed declaration and assignment papers sent to him within the requested time period and beyond, Sunil Pandit is and remains unresponsive and uncooperative. Accordingly, the above-identified patent application is made by the other inventors on behalf of themselves and the nonsigning inventor, Sunil Pandit, in compliance with 37 C.F.R. §1.47(a).

STATEMENT OF CURRENT ADDRESS

16. Upon information and belief, Mr. Sunil Pandit's current residence address is 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 USA.
17. Upon information and belief, Mr. Sunil Pandit's current telephone number is (301) 527-1324 for his residence address in Gaithersburg, MD.
18. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: April 3, 2001

By: Leslie Serunian
Leslie Serunian
Reg. No. 35,353